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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,141	06/29/2001	David John DePaolo	950270-1	5434
23879	7590	08/16/2004		
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			EXAMINER RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/896,141	<b>Applicant(s)</b> DEPAOLO, DAVID JOHN	
	<b>Examiner</b> Laurie Ries	<b>Art Unit</b> 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claims 13 and 33, the limitation "satisfying legal requirements associated with the delivery..." includes elements not actually disclosed (those encompassed by "legal requirements"), thereby rendering the scope of the claims unascertainable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-10, 13, 15, 17-18, 22-24, 26-31, 33, 35, and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hitchcock (U.S. Patent 6,345,278 B1).

As per claims 1 and 22, Hitchcock discloses a form processing system and method which includes a database for storing a number of unpopulated form data. (See Hitchcock, Figure 1, element 26). This system and method also includes a server adapted to communicate with a number of reception devices, in the form of other computers. (See Hitchcock, Figure 1, element 16, and Column 3, lines 55-56). This system and method also includes a processing application connected to the database to receive form-request data from a first one of a number of reception devices. The form-request data corresponds to a first unpopulated-form data. (See Hitchcock, Column 5, lines 21-26 and Column 6, lines 55-56). The processing application also provides the first unpopulated-form data to the first one of a number of reception devices, or computers. (See Hitchcock, Figures 9a-9c, and Column 5, lines 27-48). The processing application also receives at least one field data from the first one of a number of reception devices, or computers, which corresponds to at least one field within the first unpopulated-form data. (See Hitchcock, Column 6, lines 57-60). The processing application also stores the at least one field data uncombined with the first unpopulated-form data in the database. (See Hitchcock, Column 6, lines 62-63). The processing application also generates a second populated-form data by populating at least one field within a second unpopulated-form data with the at least one field data. (See Hitchcock, Column 7, lines 18-28). The processing application also provides the second populated-form data to at least one of the number of reception devices, or computers, wherein the at least one of a number of reception devices, or computers, is selected from a group consisting of the first

one of the number of reception devices, or computers, and any other one of a number of reception devices. (See Hitchcock, Column 7, lines 18-28).

As per claims 2 and 23, Hitchcock discloses that the first and second unpopulated-form data can be in PDF format. (See Hitchcock, Column 8, lines 28-33).

As per claims 3 and 24, Hitchcock discloses that the form-request data also includes a first form-request data and a second form-request data, where the first form-request data corresponds to an unpopulated-form type, such as an application, and the second form-request data corresponds to the first unpopulated-form data. (See Hitchcock, Column 6, lines 55-57).

As per claims 5 and 26, Hitchcock discloses that the at least one field data includes a social security number, which is included in the list of possible field data values included in claims 5 and 26. (See Hitchcock, Column 9, lines 32-33).

As per claims 6 and 27, Hitchcock discloses that the processing application also receives submit data from the first one of a number of reception devices, or computers, before the processing application stores the at least one field data in the database. (See Hitchcock, Column 6, lines 57-60).

As per claims 7 and 28, Hitchcock discloses that the processing application also receives field-identification data and form-request data from the at least one of a number of reception devices, or computers, and the field-identification data and form-request data correspond to one of the at least one field data and the second unpopulated-form data, respectively. (See Hitchcock, Column 7, lines 18-21).

As per claims 8 and 29, Hitchcock discloses that the field-identification data can be a social security number, which is included in the list of possible field data values included in claims 8 and 29. (See Hitchcock, Column 7, lines 29-31, and Column 9, lines 32-33).

As per claims 9 and 30, Hitchcock discloses that the processing application also generates a first populated-form data by populating the at least one field within the first unpopulated-form data with the at least one field data (See Hitchcock, Column 6, lines 55-64), and provides the first populated-form data to the first one of a number of reception devices, or computers. (See Hitchcock, Column 7, lines 13-17).

As per claims 10 and 31, Hitchcock discloses that the processing application also receives distribution data from the first one of the number of reception devices, or computers, which corresponds to at least one other one of the reception devices, or computers. (See Hitchcock, Column 5, lines 7-20).

The processing application also generates a first populated-form data by populating the at least one field within the first unpopulated-form data with the at least one field data. (See Hitchcock, Column 6, lines 55-64). The processing application also provides the first populated-form data to the at least one other one of a number of reception devices, or computers. (See Hitchcock, Column 7, lines 13-17).

As per claims 13 and 33, Hitchcock discloses that the processing application also provides a proof-of-service form to the at least one other one of the number of reception devices, or computers, which satisfies legal

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requirements associated with the delivery of the unpopulated-form data populated with the at least one field data. This is accomplished through the delivery of a web page form displaying user account information. (See Hitchcock, Column 4, lines 54-63).

As per claims 15 and 35, Hitchcock discloses that the processing application also receives user-account data from the at least one of a number of reception devices, or computers, which corresponds to a membership status of a user operating the at least one of a number of reception devices, or computers. (See Hitchcock, Column 12, lines 34-48).

As per claims 17 and 37, Hitchcock discloses that the processing application receives search-criteria data from the first one of a number of reception devices, or computers, which is used by the processing application to search for data stored in the database. (See Hitchcock, Column 16, lines 23-27).

As per claims 18 and 38, Hitchcock discloses that the data can include unpopulated form data, such as address information, which is included in the list of possible values included in claims 17 and 37. (See Hitchcock, Column 16, lines 7-35).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which



said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 19-21, 25, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchcock (U.S. Patent 6,345,278 B1) as applied to claims 1, 3, 22, and 24 above, and further in view of Turpin (U.S. Patent 5,742,836).

As per claims 4 and 25, Hitchcock discloses the limitations of claims 3 and 24 as described above. Hitchcock does not disclose expressly that the unpopulated-form type is selected from a list consisting of legal forms, medical forms, and vocational rehabilitation forms. Turpin discloses the inclusion of a medical information form. Hitchcock and Turpin are analogous art because they are from the same field of endeavor of processing electronic forms. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the medical information forms of Turpin with the unpopulated-form type of Hitchcock. The motivation for doing so would have been to provide the information necessary to complete additional electronic forms. (See Turpin, Column 17, lines 12-20). Therefore, it would have been obvious to combine Turpin with Hitchcock for the benefit of supplying downstream data to obtain the invention as specified in claims 4 and 25.

As per claims 19 and 39, Hitchcock discloses the limitations of claims 1 and 22 as described above. Hitchcock does not disclose expressly that the processing application receives calculation-request data and at least one new-field data from the at least one of a number of reception devices, or computers, which corresponds to at least one calculated value, calculates the calculated value using the at least one new-field data and provides the at least one

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calculated value to the at least one of a number of reception devices, or computers. Turpin discloses that a calculation is made using a new value received by the processing application which is then transmitted to the client computers. (See Turpin, Column 2, lines 55-64, and Column 17, lines 8-26). Hitchcock and Turpin are analogous art because they are from the same field of endeavor of processing electronic forms. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the new-field data and subsequent calculation of Turpin with the processing application of Hitchcock. The motivation for doing so would have been to take into account and utilize the data entered into the form in the course of completing the form, thus saving time for the operator of the system. (See Turpin, Column 1, lines 66-67, and Column 2, lines 1-6). Therefore, it would have been obvious to combine Turpin with Hitchcock for the benefit of improved system efficiency to obtain the invention as described in claims 19 and 39.

As per claims 20 and 40, Hitchcock discloses the limitations of claims 1 and 22 as described above. Hitchcock does not disclose expressly that the processing application receives calculation-request data and field-identification data from the at least one of a number of reception devices, or computers, which correspond to at least one calculated value and one of at least one field data, respectively. Hitchcock also does not disclose expressly that the processing application calculates the at least one calculated value using the at least one field data linked with the one of the at least one field data, and provides the at least one calculated value to the at least one of the number of reception devices, or

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computers. Turpin discloses that the system receives the calculation request and field identification information and calculates a value. This value is further transmitted to a computer attached to the network. (See Turpin, Column 2, lines 55-64, and Column 17, lines 8-26. Hitchcock and Turpin are analogous art because they are from the same field of endeavor of processing electronic forms. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the calculation request, field identification data and subsequent calculation of Turpin with the processing application of Hitchcock. The motivation for doing so would have been to take into account and utilize the data entered into the form in the course of completing the form, thus saving time for the operator of the system. (See Turpin, Column 1, lines 66-67, and Column 2, lines 1-6). Therefore, it would have been obvious to combine Turpin with Hitchcock for the benefit of improved system efficiency to obtain the invention as described in claims 20 and 40.

As per claims 21 and 41, Hitchcock and Turpin disclose the limitations of claims 19 and 40 as described above. Turpin also discloses that the processing application requests additional-field data where the at least one calculated value is calculated using the at least one field data linked with the one of the at least one field data and the additional-field data. (See Turpin, Column 2, lines 55-64, and Column 17, lines 8-26). Hitchcock and Turpin are analogous art because they are from the same field of endeavor of processing electronic forms. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the additional-field data of Turpin with the processing

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application of Hitchcock and Turpin. The motivation for doing so would have been to take into account and utilize the data entered into the form in the course of completing the form, thus saving time for the operator of the system. (See Turpin, Column 1, lines 66-67, and Column 2, lines 1-6). Therefore, it would have been obvious to combine Turpin with Hitchcock for the benefit of improved system efficiency to obtain the invention as described in claims 21 and 41.

Claims 11, 14, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchcock (U.S. Patent 6,345,278 B1) as applied to claims 10, 13, 31, and 33 above, and further in view of Bunnell (U.S. Patent 6,192,405 B1).

As per claims 11 and 32, Hitchcock discloses the limitations of claims 10 and 31 as described above. Hitchcock does not disclose expressly that the first populated-form data is provided via email. Bunnell discloses that a Forms Processor Server delivers a populated form via e-mail. (See Bunnell, Column 13, lines 15-26). Hitchcock and Bunnell are analogous art because they are from the same field of endeavor of processing information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the e-mail distribution of Bunnell with the system and method of Hitchcock. The motivation for doing so would have been provide for a means of tracking the success or failure of delivery of the form, using a response sent from the server also via e-mail. (See Bunnell, Column 13, lines 26-29). Therefore, it would have been obvious to combine Bunnell with Hitchcock for the benefit of

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confirming the delivery of the form to obtain the invention as specified in claims 11 and 32.

As per claims 14 and 34, Hitchcock discloses the limitations of claims 10 and 31 as described above. Hitchcock does not disclose expressly that the proof-of-service form is provided via email. Bunnell discloses that a Forms Processor Server delivers a form via e-mail. (See Bunnell, Column 13, lines 15-26). Hitchcock and Bunnell are analogous art because they are from the same field of endeavor of processing information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the e-mail distribution of Bunnell with the proof-of-service form of Hitchcock. The motivation for doing so would have been provide for a means of tracking the success or failure of delivery of the form, using a response sent from the server also via e-mail. (See Bunnell, Column 13, lines 26-29). Therefore, it would have been obvious to combine Bunnell with Hitchcock for the benefit of confirming the delivery of the form to obtain the invention as specified in claims 14 and 34.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchcock (U.S. Patent 6,345,278 B1) as applied to claim 10 above, and further in view of McCormick (U.S. Publication 2002/0120573 A1).

As per claim 12, Hitchcock discloses the limitations of claim 10 as described above. Hitchcock does not disclose expressly that the at least one other one of a number of reception devices is a fax machine. McCormick

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discloses that an online form can be sent via a fax machine. (See McCormick, Page 11-12, paragraph 0234). Hitchcock and McCormick are analogous art because they are from the same field of endeavor of processing information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the fax machine of McCormick with the system and method of Hitchcock. The motivation for doing so would have been to provide a means of returning a signature to the sender. (See McCormick, Page 11-12, paragraph 0234). Therefore, it would have been obvious to combine McCormick with Hitchcock for the benefit of providing for the delivery of signature upon receipt of the form to obtain the invention as specified in claim 12.

Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchcock (U.S. Patent 6,345,278 B1) as applied to claims 1 and 22 above, and further in view of Good (U.S. Patent 6,314,404 B1).

As per claims 16 and 36, Hitchcock discloses the limitations of claims 1 and 22 as described above. Hitchcock does not disclose expressly that the processing application receives state-designation data from the first one of the number of reception devices, or computers, which is used by the processing application to provide the first one of the number of reception devices, or computers, with unpopulated-form data pertaining to a particular state. Good discloses that the data can be searched by state, thereby returning data applicable only to the state for which the user requested the data. (See Good,

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Column 6, lines 9-17 and lines 30-39). Hitchcock and Good are analogous art because they are from the same field of endeavor of processing information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the state-specific information of Good with the system and method of Hitchcock. The motivation for doing so would have been to present the data in a geographically categorized manner for review by the requestor. (See Good, Column 6, lines 51-55). Therefore, it would have been obvious to combine Good with Hitchcock for the benefit of improved data organization to obtain the invention as specified in claims 16 and 36.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

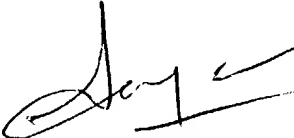
- Yaksich (U.S. Patent 5,563,998) discloses a system and method for the electronic design, storage, and distribution of business forms maximizes all of these functions, utilizing a forms automation platform and a central library facility.
- Trigg discloses a study of the use of technology within a governmental labor inspection agency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number

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is 703-605-1238. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR



SANJIV SHAH  
PRIMARY EXAMINER